



PATENT APPLICATION  
Doc. No. 7060-003

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Stanley C. Johnson                      Conf. No.      1478  
Serial No.:                      09/903,795                      Art Unit.:      1745  
Filed:                      July 11, 2001                      Examiner:      Jane J. Rhee  
For:                      WOOD PRODUCT HAVING A COMPOSITE SUBSTRATE  
                                 COVERED WITH PAPER  
Date:                      September 1, 2006

Mail Stop Appeal Brief—Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**AMENDED APPELLANT'S BRIEF  
UNDER 37 CFR § 41.37**

Further to the Notification of Non-Compliant Appeal Brief dated August 4, 2006, Applicant submits this Amended Appellant's Brief.

Appeal is taken from the Examiner's Office Action mailed May 2, 2005 finally rejecting claims 24-43 in this application.

This Appeal Brief is in furtherance of the Notice of Appeal mailed in this case on August 2, 2005.

The fees required under §41.20(b)(2) have been previously submitted.

A single copy of this brief is submitted in accordance with 37 CFR §41.37(a)(1).

This Brief contains these items under the following headings, and in the order set forth below.

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### **I. REAL PARTY IN INTEREST**

#### **37 CFR §41.37(c)(1)(i)**

Pacific Wood Laminates, Inc. (“Pacific Wood Laminates”) is the real party in interest.

### **II. RELATED APPEALS AND INTERFERENCES**

#### **37 CFR §41.37(c)(1)(ii)**

None.

### **III. STATUS OF CLAIMS**

#### **37 CFR §41.37(c)(1)(iii)**

Status of All the Claims:

- 1. Claims presented: 1-43
- 2. Claims withdrawn from consideration but not cancelled: 9-23
- 3. Claims canceled: 1-8
- 4. Claims pending: 24-43

of which:

- a. Claims allowed: NONE
- b. Claims rejected: 24-43

All the rejected claims, namely claims 24-43, are being appealed. The appealed claims are eligible for appeal, having been finally rejected.

#### **IV. STATUS OF AMENDMENTS**

##### **37 CFR §41.37(c)(1)(iv)**

There have been no amendments filed subsequent to the final rejection.

#### **V. SUMMARY OF THE CLAIMED SUBJECT MATTER**

##### **37 CFR §41.37(c)(1)(v)**

The present invention relates to a composite wood product used for certain applications in the residential and commercial building industries, and more particularly as a fascia, trim, siding, or wall covering product for exterior use. *See* Specification, p. 1, lines 8-10. The present embodiment includes three primary components, namely laminated veneer lumber, treated paper, and adhesive. *See* Specification, p. 2, lines 25-26.

As is shown in independent claim 24, a wood product for use as exterior trim comprises an elongate composite substrate (*see, for e.g.*, Specification, p. 3, line 9 and fig. 3, ref. 34), a core defining the interior of the substrate (*see, for e.g.*, Specification, p. 3, lines 13-14), an elongate front surface (fig. 3, ref. 36) and an elongate rear surface (fig. 6, ref. 38) (*see, for e.g.*, Specification, p. 3, lines 6-14). A pair of opposing edge surfaces extends between the front and rear surfaces, exposing the core on the edge surfaces. *See for e.g.* fig. 3, ref. 40. Treated paper (fig. 4, ref. 44) substantially covers and adheres to the front, side, and a portion of the rear surface adjacent to at least one edge surface, such that the covered portion is substantially all of the trim that is visible when installed. (*See, for e.g.*, Specification, p. 5, lines 12-16). A resin is

formed on at least the exposed surface and an adhesive is spread between substantially all of the paper and substrate. (*See, for e.g.*, Specification, p. 3, line 23, and Specification, p. 5, lines 1-3).

As is shown in independent claim 37, a wood product for use as exterior trim comprises an elongate composite substrate having a rectangular cross section (*see, for e.g.*, Specification, p. 3, line 9 and fig. 3, ref. 34), a core defining the interior of the substrate (*see, for e.g.*, Specification, p. 3, lines 13-14), an elongate front surface (fig. 3, ref. 36) and an elongate rear surface (fig. 6, ref. 38), the rear surface including a mounting surface (*see, for e.g.*, Specification, p. 3, lines 6-14). A pair of opposing edge surfaces extends between the front and rear surfaces, exposing the core on the edge surfaces. *See for e.g.* fig. 3, ref. 40. Treated paper (fig. 4, ref. 44) substantially covers and adheres to the front, side, and a portion of the rear surface adjacent to at least one edge surface, such that the covered portion is substantially all of the trim that is visible when installed. (*See, for e.g.*, Specification, p. 5, lines 12-16). A resin is formed on at least the exposed surface and an adhesive is spread between substantially all of the paper and substrate. (*See, for e.g.*, Specification, p. 3, line 23, and Specification, p. 5, lines 1-3).

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

### **37 CFR §41.37(c)(1)(vi)**

- A. The Examiner rejected claims 24-35 and 37-42 as obvious over U.S. Patent No. 5,234,519 to Talbot (“Talbot) in view of U.S. Patent No. 4,844,763 to Robbins (“Robbins) and in further view of U.S. Patent No. 5,071,688 (“Hoffman) under 35 U.S.C. 103(a).
- B. The Examiner rejected claims 36 and 43 as obvious over Talbot in view of Robbins and Hoffman and in further view of U.S. Patent No. 5,569,505 to Nichols (“Nichols”) under 35 U.S.C. 103(a).

For the convenience of the Honorable Board of Appeals, the entire Final Rejection dated May 2, 2005, has been reproduced and is attached as Exhibit "1".

## **VII. ARGUMENT**

### **37 CFR §41.37(c)(1)(vii)**

#### **I. Procedural History**

In an Office Action dated June 25, 2002, the Examiner entered a restriction requirement, setting forth three different inventions, which the Examiner indicated were unrelated. The first invention included claims 1-8, the second claims 9-15 and the third claims 16-23. Appellant elected to proceed with claims 1-8 and withdrew the remaining claims. In the August 21, 2002 Office Action, the Examiner rejected claims 1, 2, and 4-8 under 35 U.S.C. 102(b) to U.S. Patent No. 3,629,033 to Carter and claim 3 under 35 U.S.C. 103(a) as obvious over Carter in view of U.S. Patent No. 6,364,236 to Podosek. In response, on November 12, 2002, Appellant filed an amendment cancelling claims 1-8 and including new claims 24-34. The February 11, 2003 Office Action finally rejected claims 24-34 as obvious under 35 U.S.C. 103(a) over Talbot in view of Hoffman.

Appellant requested continuing examination on November 4, 2003, including previously presented claims 24-34 and new claims 35-43. On January 27, 2004, the Examiner entered an Office Action rejecting claims 24-43. Appellant amended independent claims 24 and 37, and on May 2, 2005 the Examiner responded by finally rejecting claims 24-43 under the same grounds identified in the January 27, 2004 Office Action. Appellant now appeals that final rejection.

#### **II. Rejections Under 35 U.S.C. §103(a)**

##### **A. Rejection of Claims 24-35 and 37-42 Over Talbot in View of Robbins and in Further View of Hoffman.**

Insofar as claims 24-35 and 37-42 have been rejected under the same grounds, Appellant argues the claims as a group, and the claims stand or fall as a group. The arguments below are made with respect to claim 24 on behalf of the group.

***1. The Examiner Has Not Made a Prima Facie Case for Obviousness***

To make a *prima facie* case for obviousness, the Examiner must identify some suggestion or motivation to make the combination of references, there must be a reasonable expectation of success, and the combination must teach all of the claim limitations. *See* MPEP 2143. The Examiner has failed to meet her burden as to each of these requirements.

The incentive to combine references must be readily apparent. If the incentive to combine is not readily apparent, the Examiner must explain why the combination of teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788, 1790 (B. App. & Int’f 1986). The Examiner, in making the combination, asserted that Talbot discloses the majority of the claimed elements of claims 24-35 and 37-42. *See* January 27, 2004 Office Action, page 3.<sup>1</sup> The Examiner acknowledged that while Talbot fails to disclose a treated paper covering the surfaces of the trim product, “Robbins teaches that paper may be substituted for the surface veneer sheet or may be adhesively bonded to the exposed surfaces of the wood veneer sheets **for the purpose of providing improved dimensional stability of laminated veneer lumber . . .**” *Id.*, page 4. [Emphasis added].

According to the Examiner, it would have been obvious to one having ordinary skill in the art at the time of applicant’s invention to provide Talbot with a treated paper to improve dimensional stability of laminated veneer lumber. *See* January 27, 2004 Office Action, page 4. However, the asserted motivation to combine cannot be found in the nature of the problem,

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<sup>1</sup> The Examiner’s final Office Action, dated May 2, 2005, relies on the rejections from the January 27, 2004 Office Action.

which is identified as improving the durability and appearance of the edges of the trim product. *See* Specification, page 1.

As explained by Appellant's declaratory evidence, rigidity in the edge surface, i.e. dimensional stability, caused cracking in the edge coating and was considered a failure during Appellant's research and development of the inventions the subject of this appeal. *See* DECLARATION OF STANLEY C. JOHNSON ("JOHNSON DEC.") mailed November 4, 2003, paragraph 12. Moreover, it is unlikely that the addition of paper would help to achieve dimensional stability. Thus, a motivation to combine that is at odds with the problem an applicant seeks to resolve, and in this case actually teaches away from the problem, is no motivation at all, and simply reflects hindsight vision on the part of the Examiner. *See* MPEP 2141, 2143. "Obviousness cannot be established by hindsight combination to produce the claimed invention." *In re Dance*, 160 F.3d 1339, 133, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998).

In addition to the failure of motivation, there is no reasonable expectation of success and the combination fails to disclose all of the limitations of the claims. The Examiner has acknowledged that Robbins does not disclose the use of a treated paper to cover the surface of the trim product. *See* January 27, 2004 Office Action, page 4. To make up for this, the Examiner looked to Hoffman. *See id.* However, the portion cited by the Examiner, specifically col. 2, lines 7-9, is describing a prior art process where a resin, in the absence of paper, is applied to a selection of Douglas fir plies to form a substrate.

To address the shortcomings of the portion cited by the Examiner, Hoffman describes a plywood substrate with the appearance side being covered by a medium density fiber overlay, with the edges being characterized by sanded surfaces formed by applying a void filler putty and post filler sanding. *See* Hoffman, col. 2, lines 54-58. Because references must be considered as

a whole, Hoffman, in combination with Talbot and Robbins teaches away from Appellant's invention.

In particular, the combination of Talbot, Robbins and Hoffman discloses a substrate, covered with paper on the appearance side, with the edge sides being coated with putty and sanded to give the appearance of wood. Because Robbins discloses engineered panels, rather than trim work, there is no suggestion or teaching in Robbins that the side edges are covered with veneer. For example: "[i]t is an object of the present invention to provide a panel and laminated veneer lumber having face and back veneer sheets and a mat of adhesively-bonded biomass particles . . . ." Thus, the suggestion that a "paper, ornamental wood or plastic sheet may be substituted for the surface veneer sheet or may be adhesively bonded to the exposed surfaces of the wood veneer sheets" necessarily only relates to the face and back of the engineered product, as those are the only portions that have been veneered, and thus may be substituted with paper. *See* col. 7, lines 15-19.

The result of course is that given the limitations of Robbins, which relates to panels rather than trim, because Hoffman alone discloses the use of a medium density fiber overlay, the addition of Robbins adds nothing to the obviousness analysis. However, whether the combination is Talbot/Robbins/Hoffman or Talbot/Hoffman, or perhaps even Hoffman alone, the fact remains that none of the combinations disclose treated paper substantially covering and adhered to all of the front surface, the side surfaces, and at least a portion of the rear surface adjacent at least one of the edge surfaces, the covered portion being substantially all of the trim that is visible when the trim is installed on the building, and a resin treatment formed on at least the exposed surface of the paper. As a result, the combination fails to teach all of the claim limitations, and further fails to provide a reasonable expectation of success, insofar as it only describes the prior art.



## ***2. It Would Not Have Been Obvious to Combine the References***

### ***a. Delay Cuts Against Obviousness***

The teachings of Robbins, Hoffman and Talbot have been known collectively since 1993, when the last of these contemporaneous references published as patents. Yet, in the eight year period leading up to Appellant's invention, no person of ordinary skill in the art stepped forward to make the combination and produce a product combining the features the Examiner claims to have identified in the combination.

### ***b. Objective Factors of Non-Obviousness Weigh Against Obviousness***

An applicant can also establish a case for non-obviousness through objective factors of non-obviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). The relevant objective factors presented by the present application are commercial success, long-felt need, failure of others, and copying. Each will be addressed in turn.

#### **(i) Commercial Success**

Appellant has produced both documentary and declaratory evidence that the product disclosed in the present application has enjoyed much more recent commercial success than has the earlier product, which is substantially similar to the Hoffman product.<sup>2</sup> In particular, the new product (disclosed in the present application) is "uniformly straight, smooth, and true. *See* DECLARATION OF KEN CAYLOR ("CAYLOR DECL."), submitted November 4, 2003, ¶ 2. Existing customers of Pacific Wood Laminates choose the new product over the earlier product, even when offered a discount for the earlier product, will not purchase the earlier product for resale, and find the new product superior. *See id.*, at ¶3. New customers of Pacific Wood Laminates also choose the new product over the Hoffman-type product, and wholesale customers have made sales of the new product to retail customers who would not purchase the earlier product.

See CAYLOR DECL., at ¶4. Even before the new product was available, verbal descriptions of the new product were met with enthusiasm, when compared with the problems of the Hoffman-type product. See *id.* at Exhibit A. Customers of Pacific Wood Laminates are likewise finding that their own retail customers prefer the new product to the earlier product, despite an abundance of inventory of the earlier product. See DECLARATION OF BILL SANREGRET (“SANREGRET DECL.”), submitted November 4, 2003, ¶¶ 2-5.

(ii) Long-felt but unsolved needs

As can be seen, there have been many attempts to provide an engineered wood product capable of withstanding the elements and having the appearance of wood, including the many references cited by the Examiner during the course of prosecution of the present application. The applied references make clear that there is a need in the construction industry for inexpensive, durable, paintable, weatherable, laminated veneer lumber. See Robbins, col. 2, line 65 through col. 3, line 2; Hoffman, col. 2, lines 25-35; and Specification, pages 1 and 2.

Although Hoffman stated that it solved the need for such a product, customer experience has proven otherwise. See Hoffman, col. 2, lines 25-35. Appellant has been making a product similar to that described by Hoffman since 1994/1995. See JOHNSON DECL., ¶¶ 3, 8. Other than Appellant, only one other company has been making a laminated veneer lumber with a paper face and sanded and filled edge, as disclosed in the Hoffman patent. See *id.* at ¶ 3. Since the onset of its manufacture of this Hoffman-type product, Appellant has received annually a barrage of complaints about installed Hoffman-type product, at the pace of more than one such complaint per week. The typical complaints involve a perception of glue line delamination, which in reality are caused by swollen edges and split veneers. Appellant has been resolving these

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<sup>2</sup> Declarant Stanley C. Johnson has reviewed U.S. Patent No. 5,071,688 and has declared that the product described therein is the same approach used in Appellant’s earlier product, described here as the “earlier product” or the “Hoffman-like product.” See DECLARATION OF STANLEY C. JOHNSON, ¶3.

complaints in several different ways, including the Technical Note submitted with STANLEY JOHNSON'S AMENDED DECLARATION ("JOHNSON SUPP. DECL."), submitted November 4, 2003. In addition to providing the Technical Note and epoxy repair kits, Appellant has been paying to settle claims since approximately 1994. *See* JOHNSON DECL., ¶ 6-8.

Demonstrative evidence, attached as Exhibits B and C to the JOHNSON DECL. depict the degradation problems associated with the Hoffman-type product, with Exhibits D and E depicting the same weather exposure to product constructed in accordance with the inventions disclosed in the present application.

The problems with the prior art product, the desire for an improved product in the construction and lumber industries as evidenced by the prior art patents, and the success of Appellant's new product all support the long-felt need that has been satisfied through Appellant's new product disclosed in the present application.

(iii) Failure of others

As previously discussed, the last of the references from the Examiner's combination was published as a patent in 1993, yet it was not until Appellant's product that a treated paper wrapped, LVL product was developed. The Johnson Declaration sets forth a series of trials beginning in 1995 of Pacific Wood Laminates' efforts to engineer such a product. What is of particular note about those trials is that they were conducted with other companies doing business in the same and related areas of endeavor. Despite the many attempts, it was not until the technology disclosed in the present application, that resolution was had. *See* JOHNSON DECL., ¶¶ 12-17. Thus, not only do the cited portions reflect the extensive effort and investment made by Pacific Wood Laminates, but they also reflect the combined efforts of other related companies to solve the problem.

Because the teachings of the combined references would have been available to those skilled in the art as of their publications, it can be inferred that despite knowledge of these references no one of ordinary skill in the art was able to devise a product that addressed the problems of the prior art products, including cracking, glue line delamination, swollen edges, and split veneers. *See* JOHNSON DECL., ¶ 6.

(iv) Copying

Appellant has provided evidence, by way of the Johnson Declaration that competitors have begun copying Appellant's product. In particular, a company called Veneer Profiles, based in White City, Oregon, has made an LVL product with resin treated paper wrapped on three sides and glued to the LVL substrate with polyurethane hot melt glue. *See* Johnson Dec., ¶18. Photographs of the copy are attached as Exhibit F to the JOHNSON DECL. This type of copying is yet another example of why the present application is allowable.

***3. The Examiner's Rejection of Declaratory Evidence was Unreasonable***

According to the Examiner, the Johnson, Caylor, and Sangret Declarations are insufficient to overcome the rejection of claims 24-43 because they state that the claimed subject matter solved a problem that was long-standing in the art. *See* May 2, 2005, Office Action, pages 3 and 4. Additionally, the Examiner said there is no showing that others of ordinary skill in the art were working on the problem and, if so, for how long. *See id.* Finally, the Examiner said that there is no evidence that if persons skilled in the art who were working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem.

As an initial point, Appellant notes that the Declarations support much more than long-felt need. In particular, as described above, they also support other objective factors of non-

obviousness, such as commercial success, failure of others, and copying. As such, it is improper to discount the Declarations solely on the basis of one objective factor.

As to the issue of the length of time of the long-felt need, Appellant has already established that there was an eight year interval between the publication of the last of the cited references before Appellant's product was introduced and the present application filed. In that time, while it must be presumed that those of skill in the art were aware of the patents, or at least on notice of them, not one such person stepped forward to make the "obvious" combination. Additionally, Declarant Johnson indicated that since approximately 1994 Appellant has been receiving complaints, and even lawsuits, as a result of consumer dissatisfaction with the type of product described by the combination of the references. *See* JOHNSON DECL., ¶¶ 6-8.

B. Rejection of Claims 36 and 43 Over Talbot in View of Robbins and Hoffman and in Further View of Nichols.

Because this second ground of rejection applies to two dependent claims of the group previously discussed, Appellant believes claims 36 and 43 are allowable as claims depending from allowable claims. Moreover, the arguments described above with respect to the remaining claims support the allowability of claims 36 and 43.

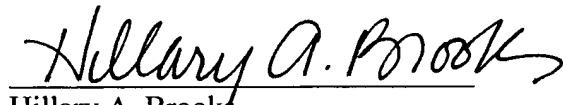
## CONCLUSION

For the foregoing reasons, which include the Examiner's failure to establish a *prima facie* case of obviousness, Appellant requests that the Board reverse the Examiner's rejections to Appellant's claims.

**Customer No. 20575**

Respectfully submitted,

MARGER JOHNSON & MCCOLLOM, P.C.



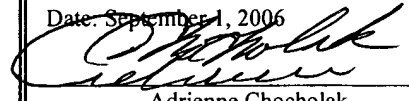
Hillary A. Brooks

Registration No. 45,815

MARGER JOHNSON & McCOLLOM, P.C.  
210 S.W. Morrison Street, Ste. 400  
Portland, Oregon 97204  
(503) 222-3613

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22313-1450

Date: September 1, 2006



Adrienne Chocholak

**CLAIMS APPENDIX**  
**37 C.F.R. § 41.37(c)(viii)**

The text of the claims on appeal is:

Claims 24-43, as follows:

24. A wood product for use as exterior trim on the exterior of a building comprising:  
an elongate composite substrate;  
a core defining the interior of said substrate;  
an elongate front surface formed on one side of said substrate;  
an elongate rear surface formed on the other side of said substrate;  
a pair of opposing edge surfaces extending between said front and rear surfaces, said core being exposed on said edge surfaces;  
treated paper substantially covering and adhered to all of said front surface, said side surfaces, and at least a portion of said rear surface adjacent at least one of said edge surfaces, said covered portion being substantially all of said trim that is visible when said trim is installed on the building;  
a resin treatment formed on at least the exposed surface of said paper; and  
adhesive spread between substantially all of said paper and said substrate.
25. The wood product of claim 24 wherein said trim is fixedly mounted on said building.
26. The wood product of claim 25 wherein said rear surface includes a mounting surface that flushly abuts the building when said trim is mounted thereon.
27. The wood product of claim 24 wherein said substrate comprises an engineered wood product.
28. The wood product of claim 27 wherein said engineered wood product comprises laminated veneer lumber and wherein said front surface comprises a surface on an outer veneer

of said substrate and said edge surfaces comprise edges of veneer layers in said laminated veneer lumber.

29. The wood product of claim 28 wherein said laminated veneer lumber comprises plywood.

30. The wood product of claim 27 wherein said engineered wood product comprises fiberboard and wherein said front surface comprises a top surface of said fiberboard and said edge surface comprises an edge of said fiberboard.

31. The wood product of claim 24 wherein said substrate has a substantially rectangular cross section.

32. The wood product of claim 31 wherein said paper covers a portion of said rear surface adjacent both of said edge surfaces.

33. The wood product of claim 24 wherein said wood product comprises siding.

34. The wood product of claim 24 wherein said wood product comprises fascia.

35. The wood product of claim 24 wherein at least one of said edge surfaces is substantially planar.

36. The wood product of claim 24 wherein at least one of said edge surfaces is substantially nonplanar.

37. A wood product for use as exterior trim fixedly mounted on the exterior of a building comprising:

an elongate composite substrate having a rectangular cross section;

a core defining the interior of said substrate;

an elongate front surface formed on one side of said substrate;



an elongate rear surface formed on the other side of said substrate, said rear surface including a mounting surface when said trim is mounted thereon;

a pair of opposing edge surfaces extending between said front and rear surfaces, said core being exposed on said edge surfaces, wherein said substrate comprises laminated veneer lumber, said front surface comprising a surface on an outer veneer of said substrate and said edge surfaces comprising edges of veneer layers in said laminated veneer lumber;

treated paper substantially covering and adhered to all of said front surface and said side surfaces, said covered portion being substantially all of said trim that is visible when said trim is installed on the building;

a resin treatment formed on at least the exposed surface of said paper; and  
adhesive spread between substantially all of said paper and said substrate.

38. The wood product of claim 37 wherein said treated paper further substantially covers and adheres to at least a portion of said rear surface adjacent both of said edge surfaces.

39. The wood product of claim 37 wherein said laminated veneer lumber comprises plywood.

40. The wood product of claim 37 wherein said wood product comprises siding.

41. The wood product of claim 37 wherein said wood product comprises fascia.

42. The wood product of claim 37 wherein at least one of said edge surfaces is substantially planar.

43. The wood product of claim 37 wherein at least one of said edge surfaces is substantially nonplanar.

**EVIDENCE APPENDIX**  
**37 C.F.R. § 41.37(c)(ix)**

Attached are copies of the DECLARATION OF STANLEY C. JOHNSON UNDER 37 CFR 1.132 ("JOHNSON DECL."), and SUPPLEMENTAL DECLARATION OF STANLEY C. JOHNSON UNDER 37 CFR 1.132 ("JOHNSON SUPP. DECL."), including all referenced exhibits, with the exception of Exhibit A to the JOHNSON DECL. which was originally submitted in error and replaced by Exhibit A to the JOHNSON SUPP. DECL. The JOHNSON DECL. and exhibits were submitted in an amendment responsive to the Office Action dated February 11, 2003, and were entered by the Examiner in the Office Action dated January 27, 2004. The JOHNSON SUPP. DECL. was submitted on November 7, 2003, and was also entered by the Examiner in the Office Action dated January 27, 2004.

Also attached are copies of the DECLARATION OF KEN CAYLOR UNDER 37 CFR 1.132 ("CAYLOR DECL."), and the DECLARATION OF BILL SANREGRET UNDER 37 CFR 1.132 ("SANREGRET DECL."). The CAYLOR DECL. and SANREGRET DECL. were submitted in an amendment responsive to the Office Action dated February 11, 2003, and were entered by the Examiner in the Office Action dated January 27, 2004.

**RELATED PROCEEDINGS APPENDIX**  
**37 C.F.R. § 41.37(c)(x)**

NONE



PATENT APPLICATION  
Docket No. 7060-003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Stanley C. Johnson

Serial No.: 09/903,795

Group No.: 1772

Filed: July 11, 2001

Examiner: Jane J. Rhee

For: **WOOD PRODUCT HAVING A COMPOSITE SUBSTRATE COVERED  
WITH PAPER**

Mail Stop RCE  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**SUPPLEMENTAL DECLARATION OF  
STANLEY C. JOHNSON UNDER 37 CFR 1.132**

I, Stanley C. Johnson, declare as follows:

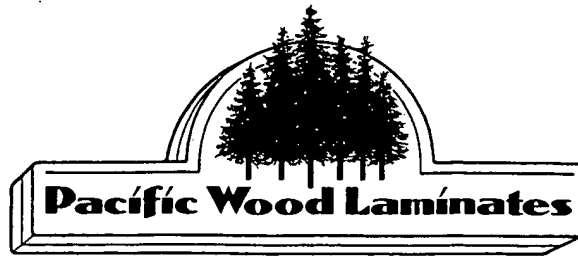
1. I executed a declaration on October 22, 2003, which was filed by Express Mail in the US Patent and Trademark Office with a November 4, 2003 submission in this application.
2. After it was filed, I reviewed a copy of the November 4 submission, and I realized that I mistakenly attached the wrong Technical Note as Exhibit A to my October 22 declaration.
3. Attached to this declaration is the correct Technical Note, which should be substituted for Exhibit A in my November 4 declaration.
4. I reviewed my October 22 declaration and found that it remains accurate when the exhibit attached to this declaration is substituted for the Exhibit A submitted with my October 22 declaration.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are

punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of any patent issued from this application.

  
Stanley C. Johnson

11/17/03  
Date



P.O.Box 820 819 RAILROAD AVE. BROOKINGS, OR 97415 PH (541)469-4177 FX (541) 469-6153

## TECHNICAL NOTE

RE: Clear Lam® Fascia and Trim Edges.

For ultimate protection, we require the use of an unthinned 100% acrylic topcoat to be applied to all surfaces as stated in the Installation and Handling guide. However, due to the nature of the wood veneers, periodic maintenance may be required along the edges to ensure the best possible aesthetics. As the wood shrinks and swells during yearly changes in climate, stress checks or small cracks may appear. This is a normal characteristic of the product and is not a manufacturing defect. We recommend that the homeowner perform an inspection of the fascia or trim product on an annual basis and apply touch-up material to specific areas as desired. We strongly recommend the use of a high quality, paintable polyurethane or acrylic caulking material for touch-up. For best results, choose a product that meets or exceeds ASTM -C920S. This reference can be found on the product's label. Be sure to follow the manufacturer's instructions.

We recommend that small amounts of the caulking material be applied into and around the stress checks and allowed to dry prior to touch-up with paint. For added protection, a thin layer of caulking material can be applied to all edge surfaces if so desired, followed by touch-up with paint.

As with all exterior wood products, the natural characteristics of wood require periodic maintenance for enhanced performance. Following these recommendations will help ensure the service life and lasting beauty of your Clear Lam® Fascia and Trim.

Rev 04.98

EXH A  
PAGE 1 OF 1



PATENT APPLICATION  
Docket No. 7060-003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Stanley C. Johnson

Serial No.: 09/903,795

Group No.: 1772

Filed: July 11, 2001

Examiner: Jane J. Rhee

For: **WOOD PRODUCT HAVING A COMPOSITE SUBSTRATE COVERED  
WITH PAPER**

Mail Stop AF  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**DECLARATION OF KEN CAYLOR UNDER 37 CFR 1.132**

I, Ken Caylor, declare as follows:

1. I am employed by Pacific Wood Laminates, Inc. (PWL), Brookings, Oregon, as General Manager of Sales and Marketing.
2. Our new product ("the wrapped edge product"), which is the subject of this patent application, is uniformly straight, smooth, and true. The wrapped edge product is certainly smarter and truer than the old PWL product, which is described in paragraph 3 of the accompanying Declaration of Stanley C. Johnson.
3. On September 3, 2003, Terry Clark, who is a PWL employee responsible for LVL and plywood sales, met with a major homebuilder in the Washington, DC area who has used both our old PWL product (with sanded and filled edges) and the new wrapped product made in accordance with the invention claimed in this patent application. He is no longer selling the old product, and when Terry offered the old product to him at a discount from the new product he was not interested because the appearance of the new product is so much better.
4. Northeastern US markets have been reluctant to take the old PWL product because of problems with its edge. The new product, however, has been successfully sold to two New York distributors who would not accept the old PWL product.

5. Attached as Exhibit A is a May 24, 2002 email from Paul Walsh who is with Holbrook Lumber Company, a PWL customer that distributes PWL products, typically to lumber yards that in turn sell to building contractors. This email was sent to me after I told Mr. Walsh about the wrapped edge product but before PWL was selling the new product and illustrates the resistance of the market in the Northeast US to the old PWL product and the desire for the new product.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of any patent issued from this application.

  
\_\_\_\_\_  
Ken Caylor

10-20-03  
Date



-----Original Message-----

**From:** JFWalsh@aol.com [mailto:JFWalsh@aol.com]

**Sent:** Friday, May 24, 2002 9:37 AM

**To:** Ken Caylor

**Subject:** Clear-Lam wrapped edge

Dear Ken,

As you are aware we have been selling the clear-lam product for several years in the Northeast market with some success. As I travel the area some of my best customers are interested in the program but are concerned about the edge. Ken I have three of my best customers that are ready to buy the program but only if the edge is wrapped. Personally I think this program will take off once we can buy the wrapped edge. One of my best customers, Hingham Lumber, is in the process of building a new lumber yard. They were so close to using the clear-lam on the building but the owner squashed the idea because the edge was not wrapped. The purchasing agent at Hingham Lumber, Mike MacCune used clear-lam on his own house and is the biggest fan of the product but the owner won't allow him to stock the product until the edge is wrapped. Bethel Mills, my number one customer wants the product in the worst way because he is having problems with the Windsor One primed pine program holding paint. Dan Kieth at Selectwood who you met at our show last year just put out his spring pricelist that goes out to 15,000 builders, contractors, and architects wants the program but only in the wrapped edge. Ken is there something we can do to expedite this matter. I know in my heart that this is a great product because I put it on my own house, but many people just don't like the looks of the edge. Please talk to Chris and keep me posted on developments that are taking place to bring this product to marketplace.

Thank You  
Paul Walsh

EXH

A

PAGE

OF



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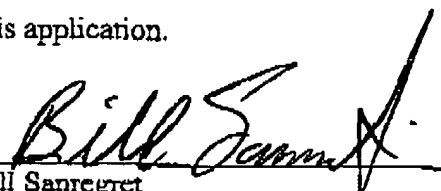
**DECLARATION OF BILL SANREGRET UNDER 37 CFR 1.132**

I, Bill Sanregret, declare as follows:

1. I am employed by Capital Lumber Company (CLC) as an Outside Salesman in CLC's Healdsburg, California office. I have been employed at CLC since 1995.
2. CLC purchases engineered lumber products—including CLEAR LAM<sup>®</sup> fascia, soffits, and trim—from Pacific Wood Laminates, Inc. (PWL) of Brookings, Oregon, which I understand is the owner of the patent application identified above. CLC has purchased this product from PWL since 1996.
3. CLC sells these products, typically to retail lumberyards that in turn sell to building contractors. CLC has sold the old-style CLEAR LAM<sup>®</sup> products, which include an exposed edge that is sanded and filled, since around 1996. CLC currently has several hundred thousand dollars worth of the old-style CLEAR LAM<sup>®</sup> products in its inventory.
4. Since at least 1997, I have received numerous complaints about the exposed edge of the old product, particularly about the poor quality of the edge seal.
5. Some of our customers refused to buy the old-style product because the edges are quickly subject to weather damage. But about 18 customers that would not buy the old-style

product due to these concerns are currently purchasing the new product, in which paper extends from the face of the product around the edge to the back, thereby wrapping and sealing the edge.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of any patent issued from this application.

  
Bill Sanregret

10-21-03  
Date



AF  
zfw

PATENT APPLICATION  
Doc. No. 7060-003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Stanley C. Johnson      Conf. No.      1478  
Serial No.:      09/903,795      Art Unit.:      1745  
Filed:      July 11, 2001      Examiner:      Jane J. Rhee  
For:      WOOD PRODUCT HAVING A COMPOSITE SUBSTRATE  
            COVERED WITH PAPER  
Date:      September 1, 2006

Mail Stop Appeal Brief—Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TRANSMITTAL LETTER**

Enclosed for filing in the above-referenced application are the following:

- ☒ Amended Appellant's Brief Under 37 CFR § 41.37
- ☒ Evidence Appendix coversheet and attachments (19 pages)
- ☒ Any deficiency or overpayment should be charged or credited to deposit account number 13-1703.

Customer No. 20575

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

*Hillary A. Brooks*

Hillary A. Brooks  
Reg. No. 45,815

MARGER JOHNSON & McCOLLOM, P.C.  
210 SW Morrison Street, Suite 400  
Portland, OR 97204  
503-222-3613

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is being deposited with the United States  
Postal Service as first class mail in an  
envelope addressed to: Commissioner for  
Patents, P.O. Box 1450, Alexandria, VA  
22313-1450  
Date: September 1, 2006  
*Adrienne Chocholak*  
Adrienne Chocholak